

**REMARKS**

By this Amendment, Applicants amend claims 24 and 38 for clarity and add claim 50. Thus, claims 24, 28-38, and 40-50 are pending. Support for claim 50 may be found at least in Fig. 26 and the associated disclosure. Applicants respectfully request reconsideration and prompt allowance of the claims at least in light of the following remarks.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Mehrpour in the December 6, 2006 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

The Office Action rejects claims 24, 28-33, 35-38, 40-45 and 47-49 under 35 U.S.C. §103(a) over U.S. Patent No. 6,522,421 to Chapman et al. (Chapman) in view of U.S. Patent No. 6,223,029 to Stenman et al. (Stenman) and further in view of U.S. Patent No. 6,173,338 to Fukuta. Applicants respectfully traverse the rejection.

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In order to establish a *prima facie* case of obviousness, three criteria must be met (MPEP §§ 2142, 2143). 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to modify the reference or combine reference teachings. 2) There must be a reasonable expectation of success. 3) The prior art reference (or references when combined) must teach or suggest all of the claim limitations. The first two criteria must both be found in the prior art, and not based on Applicants' disclosure. Applicants respectfully submit that the Office Action fails to satisfy the first and third criteria.

In particular, with respect to the first criteria, the Office Action fails to identify a suitable motivation for modifying the device of Chapman based on the alleged teachings of Stenman. In this respect, the Office Action alleges that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Stenman with Chapman "in order to provide security to the user not only for sensitivity of the information but also for the accessibility and location of the receiving equipment" (Office Action, p. 4).

However, neither Chapman nor Stenman in any way disclose, teach, or suggest that using a cellular telephone with a printer device would provide security to the user not only for sensitivity of the information but also for the accessibility and location of the receiving equipment. Accordingly, the Office Action has failed to identify a motivation in the references themselves, to modify the reference or combine reference teachings. The Office Action has failed to provide any evidence that such motivation is within the knowledge generally available to the skilled artisan. Therefore, the Office Action's alleged motivation for combining Chapman and Stenman fails to meet the minimum requirements of MPEP §§ 2142, 2143.

The Office Action also fails to identify a suitable motivation for modifying the combination of Chapman and Stenman based on the alleged teachings of Fukuta. In this respect, the Office Action alleges that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Fukuta with Stenman modified by Chapman "in order to provide an image output and for beginning to output the image data after an output condition has been designated" (Office Action, p. 4). However, this alleged two-part motivation cannot be considered a motivation.

First, both Chapman and Stenman disclose outputting an image; thus, the skilled artisan would not need to modify either of Chapman or Stenman based on the alleged teaching of Fukuta to provide an image output. Therefore, the first part of the Office Action's

alleged motivation for combining Chapman and Stenman with Fukuta fails to meet the minimum requirements of MPEP §§ 2142, 2143.

Second, the Office Action alleges it would have been obvious to modify Chapman and Stenman to receive an instruction to print the image information from the cellular phone after storing the image information in the memory for the benefit of beginning to output the image data after an output condition has been designated. Motivation must suggest the desirability of the combination, i.e., why the skilled artisan would modify Chapman and Stenman based on the alleged teaching of Fukuta (MPEP §2143.01(I)). Here the Office Action is alleging that the feature itself is motivation rather than identifying a reason why the skilled artisan would add the feature. Without identifying a reason why the skilled artisan would add the feature, the Office Action is simply alleging that the skilled artisan could modify Chapman and Stenman based on the alleged teaching of Fukuta. It is well settled that the fact that the skilled artisan could modify the references is not enough to support a prima facie case of obviousness (MPEP §2143.01(III)). Therefore, the second part of Office Action's alleged motivation for combining Chapman and Stenman with Fukuta fails to meet the minimum requirements of MPEP §§ 2142, 2143.

Furthermore, the Office Action's conclusion of obviousness is based on improper hindsight reasoning because "express" motivation to combine the references is lacking (see MPEP §2145(X)(A)).

In Fukuta, the memory storing the image information is provided on the image processing apparatus 110 which outputs to the digital color copying machine 120 a signal indicating that the image information is stored in the memory. On the other hand, in the claimed invention, the memory storing the image information is provided on the image forming device, and the image forming device then receives a command to print the image

information. The image forming device outputs to a cellular phone a signal indicating that the image information is stored in memory.

Thus, it appears that the Examiner has observed the above-explained relationship between the image forming device and the cellular phone and through hindsight has correlated the image forming device, of the claimed invention, with the image processing apparatus 110, in Fukuta. Similarly, the Examiner has applied hindsight in correlating the cellular phone, in the present invention, with the digital color copying machine 120 in Fukuta

With respect to the third criteria of a *prima facie* case of obviousness, neither Chapman, Stenman, nor Fukuta disclose, teach, or suggest "after storing the image information in the memory, outputting to a cellular phone a signal indicating that the image information is stored in the memory," as recited in claim 24 and similarly recited in claim 38.

The Office Action admits that Chapman fails to disclose, teach, or suggest this feature (Office Action, p. 3). The Office Action relies on col. 6, line 67 - col. 7, line 24, of Stenman as disclosing this feature. However, that portion of Stenman simply discloses that the command control module 2025 of the mobile station 2000 controls peripheral devices 2040, and that the peripheral devices 2040 may include a printer. Importantly, Stenman does not disclose, that the peripheral devices 2040 output a signal to the mobile station 2000 indicating that the image information is stored in the memory. Furthermore, during the personal interview, Examiner Mehrpour was unable to explain how the recited portions of Stenman meet this claim limitation, nor was she able to find it elsewhere in the cited application. Thus, Stenman fails to disclose, teach, or suggest, "after storing the image information in the memory, outputting to a cellular phone a signal indicating that the image information is stored in the memory," as recited in claim 24 and similarly recited in claim 38. Fukuta fails to make up for this feature. Thus, Chapman, Stenman, and Fukuta fail to disclose all of the features of claims 24 and 38.

In view of at least the foregoing, claims 24 and 38 are patentable over Chapman, Stenman, and Fukuta. Further, claims 28-33, 35-37, 40-45 and 47-49 are patentable for at least the reasons that claims 24 and 38 are patentable, as well as for the additional features they recite.

The Office Action rejects claims 34 and 46 under 35 U.S.C. §103(a) over the combination of Chapman, Stenman, and Fukuta in view of WO 94/26059 to Peyser et al. (Peyser). Applicants respectfully traverse the rejection.

This rejection is premised upon the presumption that the combination of Chapman, Stenman, and Fukuta discloses, teaches, or suggests all of the features of claims 24 and 38. Because, as discussed above, the combination of Chapman, Stenman, and Fukuta does not disclose all of the features of claims 24 and 38, the rejection is improper. Applicants respectfully request withdrawal of the rejection.

In view of at least the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicit favorable reconsideration and prompt allowance of the pending claims.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, Applicants invite the Examiner to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff

Registration No. 27,075

John A. Radi

Registration No. 59,345

JAO:JAR/tbm

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**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

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